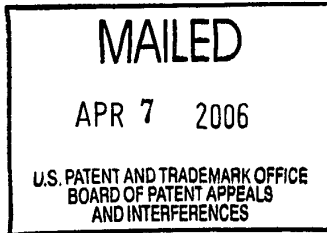


UNITED STATES PATENT AND TRADEMARK OFFICE



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YASUHIRO HARITA  
and  
TOSHIHIRO SATO

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Application 09/788,428

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on January 24, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

A review of the Image File Wrapper (IFW) indicates that in the Final Rejection mailed November 4, 2002, the following rejections were made:

1. Claims 1, 4, 5, 9, 14, and 15 under 35 U.S.C. 102(b) as being anticipated by Strobl (U.S. Patent no. 5,360,274) [page 2];

2. Claims 1, 4-6, 9, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Winkelmann (U.S. Patent no. 3,770,990) [page 2]; and

3. Claims 2, 3, 7, 8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strobl in view of Rose (U.S. Patent no. 3,239,287) [page 3].

However, in the Examiner's Answer mailed August 11, 2003, the examiner lists only the following rejection:

1. Claims 2-5, 7, 8, and 11-15 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action Paper No. 7 [Final Rejection mailed November 4, 2002].

It appears that the addition of claims 4, 5, 14, 15 to the § 103(a) rejection of claims 2, 3, 7, 8 and 10-13 as being unpatentable over Strobl in view of Rose (U.S. Patent no. 3,239,287) constitutes a new ground of rejection.

At the time the Examiner's Answer was mailed, 37 CFR § 1.93(a)(2) prohibited the entry of a new ground of rejection. See § 1208.01 of the Manual of Patent Examining Procedure (MPEP) (Rev. 1, February 2003), which states:

37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of

the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

However, on September 13, 2004, 37 CFR § 1.93 was abolished and replaced with 37 CFR § 41.39, which is reproduced below.

§ 41.39 Examiner's answer.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief including such explanation of the invention claimed and of the references relied upon and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner determines that the appeal does not comply with the provisions of §§ 41.31 and 41.37 or does not relate to an appealable action, the primary examiner shall make such determination of record.

(2) An examiner's answer may include a new ground of rejection.

(b) If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or

submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

As can be seen, an Examiner's Answer mailed after September 13, 2004, may include a new ground of rejection. In order to include

a new ground of rejection in the Examiner's Answer, the examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

[www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html](http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html)

The requirements for a new ground of rejection are:

- 1) Approval by a Technology Center Director or designee; and
- 2) Prominently identified, by a separate heading with all capital letters in the following sections of the Examiner's Answer:

Grounds of Rejection to be Reviewed on Appeal section, and

Grounds of Rejection section.

To correct this problem, the examiner will need to vacate the Examiner's Answers mailed August 11, 2003 and June 21, 2005 (which clarified the rejection). Once the Examiner's Answers are vacated, the examiner has the following options:

- 1) to write a new Examiner's Answer without the new grounds of rejection;

- 2) to reopen prosecution; or
- 3) to write a new Examiner's Answer properly setting forth the new grounds of rejection.

In addition, MPEP § 1208 states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

The above-noted Examiner's Answers do not comply with the above requirement.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- 1) vacate the Examiner's Answers mailed August 11, 2003 and June 21, 2005;
- 2) to select one of the following options:
  - a) reopen prosecution;
  - b) write a new Examiner's Answer without the new grounds of rejection; or

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c) write a new Examiner's Answer properly setting forth the new ground of rejection;

2) to take corrective action regarding the names of the conferees participating in the appeal conference; and

3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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